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EXAMINER

HARRISON, JESSICA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,782

Applicant(s)

HOLCH ET AL.

Examiner

Jessica J. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53-102, 112-114 and 119-157 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-102, 112-114 and 119-157 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on filing is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This application is a continuation of prior application Ser. No. 08/877,375.

Applicant's amendment of January 12, 2004 is acknowledged. The specification has been amended on page 2. Claims 1-52, 103-111, and 115 - 118 have been cancelled. Claims 53-102, 112-114, and 119-157 are pending. Claims 57, 60, 64, 67, 72, 77, 80, 84, 87, 92, 93, 94, 98, 99, 112, 113, 119, 120, 122, 123, 127, 132, 138, 143, 145, 147, 150, 153, 154, 155 and 157 have been amended.

### ***Specification***

The amendments filed 8/30/2002 and 2/3/2003 are objected to under 35 U.S.C. 132 because each introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the amendment of 8/30/2003, the second paragraph remaining states " an interface to receive, ..., game information on a per-game basis, and *a processor for adjusting the player account balances on a per game basis*". As currently amended, the passage of contention reads "...an interface to receive, from the plurality of game terminals, player activity information on a per-game basis and *a processor for adjusting the player account balances on a per game basis*". This language, previously delineated, still contains new matter.

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The prior application, which matured into US Patent 6,280,328 states that both the game information (as defined herein) and the game results are sent to the account server after game play. Col8:18 – 26 and Fig5b step 542. While “after” each game is “per-game”, per-game clearly encompasses during the game and prior to the game, possibilities that clearly are not encompassed by the prior disclosure. It is noted that the prior application disclosed an account validation prior to game play, as well as an account determination of sufficient funds. The prior disclosure does state the account balances in the terminal and central are monitored on a “per-game” basis (to detect fraud as early as possible) and that “activity information” is sent in “real time” and that “tracking of player activity on a per-game basis helps tailor player terminals”. “Activity information” is separately defined from “game information”. This, however, is not the same as adjusting the player account balances on a “per-game” basis. Furthermore, it is clear from a reading of the original disclosure that the processor updates account balances **after** each game. See Fig 5b, step 546, at least. Therefore, the specification as originally filed does not provide support for adjusting of account balances on a per-game basis.

As amended in the newly presented claims, applicant has now defined the player activity information, which as claimed is transmitted on a per-game basis, to include “game information”. The original specification made it clear that the game information was transmitted after each game. Furthermore, it is

defined separately from the player activity information. Therefore, as presented the language is new matter.

Further, as amended in the newly presented claims, applicant has changed that which was previously defined as game information to be defined as player activity information. For example, claim 84 now reads “the additional player activity information including at least one of the result of the game, player’s updated account balance, a player terminal number, a game type code, a game number, a date and a time.” This is defined as “game information” in the specification, (parent patent, col. 8 lines 17 – 22) and distinguished from player activity information in the specification (parent patent, col. 8 lines 52 – 60). Applicant cannot just rename/redefine information in the claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

Claims 80-86, 87-92, 98-102, 112 – 114, 119 – 121, 143 – 146, 149, 150- 156 and 157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite updating account information on a per-game basis. This language constitutes new matter as described hereinabove.

Claims 72, 94, and 99 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite game information as being a part of the player activity information. This language constitutes new matter as described hereinabove.

Claims 84, 92, 112, 113, 120 and 157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite that which was previously defined as game information to be defined as player activity information. This language constitutes new matter as described hereinabove.

It is believed all instances of the types of new matter situations described above have been noted. However, due to the number of the claims, it is possible some offending claims have been inadvertently omitted. Applicant is thanked in advance for his cooperation in ensuring all claims presented are clear, concise and do not encompass new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 53 – 59, 60 – 66, 67-72, 80-86, 151, 152, 87-92, 93 – 97, 112-114, 119, 121, 122, 123, 145-150, 155-157 are rejected under 35

U.S.C. 102(b) as being anticipated by Hedges et al. (4,467,424). This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language is directed to issues of clarity and new matter and continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

Hedges discloses a remote gaming system which enables player's participation in selected wagering games from a remote terminal 10. The system includes a player terminal 10 which has at least touch input means, display means and ID/Account card reading means as well as software to execute the terminal functions and display. The system also includes a central

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controller 9 (called the credit station) and a croupier station where random numbers are generated. Given the number of claims presented, and that the claims differ only slightly in scope and variation of language, an exhaustive listing of each claim with respect to Hedges is not being made. The interpretations of Hedges in light of the claim language will be discussed while limitations in the instant claims not discussed herein below are deemed to be readily apparent from a reading of Hedges. The claimed "means to transmit game information for each game" is taught at Hedges 13:11-12 and 13:36-37. The claimed "means for executing application program in response to an externally generated random number" is Hedges display processing application program, which executes in response to the random numbers generated at the croupier station (external) in order to display the game results to the player. This functions as a means for determining a game result as well. The claimed "means for adjusting the account after a game" is taught in Hedges at 13:61, 62 – the central updates the account after the game. Player identification is transmitted in the activation step taught in col 12 of Hedges. As for the claimed game information – Hedges transmits the game selection and the wager amount, at least. Hedges terminals do not use money. Hedges central credits upon game win, and debits upon game loss, after each game. Hedges encompasses a "terminal", a "central", a "system", and as he is operated with a combination of hardware and software, Hedges includes "a computer-readable medium containing instructions for causing a computer to perform a method of



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operating gaming systems..." as claimed. Hedges is deemed to meet the claims as broadly claimed.

Claims 73 – 79, 124, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143 and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by Franchi (5,770,533).

This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language is directed to issues of clarity and new matter and continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

These claims share the feature of the transmission of game information to the central from the terminal after a game is played. Franchi includes a plurality of remote game terminals and a central computer. Game choices and amounts wagered are entered at player terminals. Game results are determined, displayed, and transmitted to the central which maintains player account balances additionally to those stored on the card. See 6:30- 36 and 7:30 – 45, at least. See also step 306 of Figure 3 where both balances are checked as a security feature. The reference is deemed to meet the claims as broadly claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 126, 128, 131, 133, 135, 137, 140, and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi. This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language is directed to issues of clarity and new matter and continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

Franchi's random numbers used for game play appear to be generated internally of the terminal, or externally (use of Franchi with actual cards or table games) but not from the central or from a random number server. However, computer generation of random numbers is notoriously old and well known and capable of instant demonstration. Use of computerized RNG's in a gaming environment has been popularized in that it appears safer to some players who may think a dealer will cheat them. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Franchi with games utilizing computer generated random numbers, particularly generated centrally, so that players may perceive the game is fair.

Claims 120, 153 and 154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedges in view of Franchi.

Hedges fails to send the game information from the terminal to the central as recited in claim 120, and to check balances for security reasons as recited in claims 153, 154. Both of these are done in Franchi, in order to enhance security. It would have been obvious to one of ordinary skill in the art at the time of the invention to update the central after each game, to maintain duplicate balances and to compare balance calculations in Hedges as is done in Franchi, in order to provide a secure game system desirably taught by Franchi.

#### ***Response to Arguments***

Applicant's arguments filed January 12, 2004 have been fully considered but they are not persuasive.

With respect to the Information Disclosure Statement enclosed is a signed copy of applicant's PTOL 1449 dated 10/9/2003. The examiner remains unable to located copies of the other documents not yet considered from applicant's IDS of 1/4/2002. All related files will be ordered and reviewed in due course.

With respect to the Specification Objections, applicant correctly states that which is contained in the prior disclosure. However, as noted above, this is inconsistent with that which applicant claims in the instant claims. For example, the specification states that the account server stores account

language. Presenting a display is a determination, at least to the specificity claimed.

Finally, applicant urges Hedges fails to disclose a method including the steps of executing an application program at one of a plurality of game terminals in response to an externally generated random number and displaying, by one of the plurality of game terminals, the result of the game. This is parallel to the argument above. The application program is met by the display program and a display monitor displays an updated balance “in response” to an externally generated random number. The reference continues to anticipate.

With respect to Franchi, applicant submits Franchi fails to disclose the step of receiving at one of a plurality of game terminals, a game choice and a wager amount for a game, or the parallel of means for receiving a game choice and a wager amount. Applicant states that Franchi discloses a series of individual game computers each set up to monitor one game and therefore Franchi has no need for the game computer to receive a game choice. Respectfully, applicant is selectively reading the Franchi reference. Applicant quotes col 5 for support of his position. However, had applicant ventured further into the reference, particularly to Figure 6 and col8 lines 30 – 40, at least, he would have seen that each game of Franchi provides a video display screen allowing a player to additionally play one of at least a network lottery, bingo, keno, or any system game run casino-wide or even world wide while

playing the original game. A display and control buttons are taught.

Therefore, Franchi indeed teaches and has reason and need for that which the examiner purported. Accordingly, Franchi continues to anticipate.

This argument serves as the basis for all arguments against the 103's based upon Franchi as well. The examiner has pointed out direct support for the means for receiving a game choice and a wager amount in Franchi. Therefore, the 103 rejections, having not been otherwise challenged, stand as proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone

information, card information and game information. This, however, does not provide support for the claimed card information and game information being a type of activity information.

With respect to the Section 112 Rejections, as outlined above, while some of applicant's amendments have resolved the prior delineated problems they have created new problems or failed to resolve the prior problem in total.

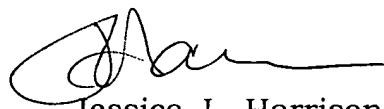
With respect to the anticipatory rejections based upon Hedges, Applicant submits that Hedges fails to teach every element of the claims and therefore must fail to anticipate. Applicant urges Hedges fails to disclose a game terminal including both a means for executing an application program in response to an externally-generated random number and a means for displaying the result of the game. Applicant notes the examiner's interpretation of the reference with respect to the software and insists the reference then fails to teach a means for displaying the result of the game. Clearly applicant overlooks the CRT display which displays the result of the game and therefore meets the claimed structure and function. Both recited elements are taught in the Hedges reference.

Next, applicant argues Hedges fails to disclose a player terminal including means for determining the result of a game as recited in amended claim 60. The examiner interprets the game processing/display processing of the terminal which receives the data from the croupier station to meet this

number is 703-308-2217. The examiner can normally be reached on M-F during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

JJH